

Action dated January 4, 2005 would be found allowable unless an additional search located more pertinent art. Examiner Zeade expressly stated that he would need to conduct an additional search. Obviously, Examiner Zeade believed that the reasoning provided by the applicant's representative during the interview was compelling. Examiner Alavi did not disagree. In spite of Examiner Zeade's statement, the Official Action of April 13, 2005, did not cite or apply more pertinent art. Even so, the claims tentatively agreed to as avoiding the Kawahara reference were again rejected with Kawahara as the primary reference in the Official Action dated April 13, 2005, this rejection apparently coming at the behest of Examiner Zeade's supervisory examiner who did not participate in the interview noted above.

Applicant's representative requested and was granted a second interview held on April 19, 2005. During this interview, the applicant's representative attempted to point out the deficiencies of the Kawahara patent in view of the claims amended as a result of the first interview, but was met only with the contention that the supervisory examiner would not allow the claims previously agreed to at least tentatively by two examiners. For reasons detailed in the Record of Interview made a part of this prosecution history, this application is now the responsibility of another senior examiner.

The examiner who now has responsibility for this patent application unfortunately finds a situation wherein the claims are under final rejection. Even so, request is made for a complete consideration of the allowability of the claims now asserted as if the final rejection had not been entered. No new issues are raised by the reasons to be detailed herein nor has the applicant himself caused a need for a new search. Any additional search would be undertaken at the examiner's instigation.

Considering now the applicant's reasons for the allowability of claims 1 through 20 now pending, the rejection of claims 1 through 20 under 35 USC 112, first paragraph, should be discussed initially. The rejection is based on the introduction of new matter, that is, by the language now present in the claims relating to the recited pattern on the disclosed luminaire as being "impervious to light" as in claims 1 through 18 or "opaque" as in claims 19 and 20. The previous examiner apparently contends that disclosure of this nature is not present in the application as filed.

Attention is directed to page 8, lines 22 and 23 wherein a luminaire configured according to the invention is disclosed as being formed of a metal material having a thickness of 0.036 inch in a preferred embodiment. Clearly, light emanating from a conventional lamp used for illumination of an environmental space would not penetrate a material made of metal and having the exemplary thickness. Basis therefore exists for the language present in the claims. Moreover, the gist of the invention as disclosed in its totality clearly leads to a conclusion that light is not intended to pass through those portions of a luminaire on which a pattern is disposed according to the invention. The disclosure clearly provides a basis for the language added to the claims.

If the examiner believes that this language should be placed in the written specification, the applicant will comply and believes that such an addition to the written specification would not constitute new matter because of the disclosure noted above.

The rejection of the claims under 35 USC 112, first paragraph, is therefore believed to be without basis. Withdrawal of this rejection is requested.

In the Official Action dated April 13, the previous examiner objected to claims 1, 9, 11 and 17 without specification of a statutory basis, the examiner apparently believing

that the term "thing" is indefinite. Basic grammar defines a noun as a "person, place or thing", with the term "thing" being equally as definite as the terms "person" or "place". As such, the applicant is simply using a time-honored definition of a very definite concept, that is, a "noun" and believes that the language is clearly appropriate and that basis for this language is provided throughout the present specification. Without belaboring this point, perhaps the previous examiner should have considered the terms "person" and "place" to be equally as "indefinite" as the term "thing". Not having done so, an effective argument cannot then be advanced for a contention that the third leg of the definition of a noun, that is, the term "thing", is "indefinite". Withdrawal of this objection is requested.

Claims 1, 9, 17 and 19 as presently asserted are rejected under 35 USC 102(e) as anticipated by Kawahara. While the applicant believes that the discussion held with Examiners Zcade and Alavi during the interview of January 14 and the tentative agreement believed to have been reached should remove the Kawahara reference from consideration relative to the claims now asserted, the applicant would additionally like to point out compelling reasons for the removal of Kawahara as a reference.

Kawahara discloses apparatus intended to project images on a nearby wall or the like. The Kawahara apparatus essentially comprises a light bulb having a sheet of material mounted in proximity to the light bulb, the sheet of material having apertures formed therein so that light from the light bulb passes through the apertures and appears on the wall as illuminated areas having shapes similar to the shapes of the apertures. As such, the Kawahara apparatus is essentially a "projector" that functions identically to a "movie" projector in a theater. Contrary to the examiner's contentions, Kawahara

absolutely does not intend nor does he produce a pattern on surfaces of a luminaire whereby an association with a person, place or thing is evoked. Kawahara provides absolutely no disclosure of configuring a surface of a luminaire to provide such an association. A person of ordinary skill in the art on reading the Kawahara patent would not come away with the teaching that he could devise a luminaire with surfaces patterned to produce the emotion and feelings and associations taught by the present disclosure and recited in the claims herein asserted.

At best, any evocation of association brought about by Kawahara and his explicit teachings occurs as a result of a pattern projected onto a wall, not a pattern formed on a luminaire. Kawahara absolutely does not describe or contend that the apertures formed in his sheet of material function to evoke an emotional association or any other feeling or mood. Clearly, Kawahara does not form a pattern on a surface of a luminaire wherein the surface and pattern are opaque or impervious to light. As such, a rejection under 35 USC 102(e) is completely inappropriate since the reference does not disclose each and every element of the claims.

Kawahara can only be used as a reference in light of the applicant's own disclosure, that is, the previous examiner is using hindsight afforded by the applicant's own disclosure, a practice clearly not permitted under the law.

The rejections of claims 2, 4, 8, 10, 11 and 20 under 35 USC 103(e) as unpatentable over Kawahara also fail for essentially the same reasons noted relative to the rejection under 35 USC 102(e).

Claim 2-8, 10-18 and 20 are rejected under 35 USC 103(e) as unpatentable over Kawahara in view of Fellend. Kawahara is deficient as noted above. Fellend merely

discloses a light fixture that happens to be a shoplight. Fellend provides absolutely no pattern on light impervious surfaces of the disclosed shoplight. No disclosure is provided in Kawahara or Fellend that would cause a person of ordinary skill in the art to combine the two patents. Rejection of any claim herein asserted in view of a combination of Kawahara and Fellend is untenable.

The Examiner's attention is again directed to the compelling statement definitely made by Examiner Zeade during the interview of January 14, 2005, that is, that a "new search" might turn up art more appropriate than Kawahara. If the examiners had not concluded that Kawahara was deficient as contended by the applicant's representative during the interview, then why would Examiner Zeade have made such a statement and why would Examiner Alavi have concurred? The law very clearly states that a conclusion affirmative of an applicant's position is appropriate in situations involving a close question. The fact of the tentative agreement reached during the January 14 interview shows that, at worst, patentability is a close question and should be resolved in favor of the applicant. The applicant contends, however, that the patentability of claims 1 through 20 as herein asserted is not a close question at all but is very clear. Claims 1 through 20 avoid the prior art and are free of objections under 35 USC 112, first paragraph, or otherwise.

Allowance of claims 1 through 20 is respectfully requested.

Respectfully submitted,


Kenneth E. Darnell
Reg. No. 26541

2010 West 7th Street
Coffeyville, Kansas 67337
620 251-1947